

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed May 30, 2008. A Petition for Extension of Time is submitted herewith, together with the appropriate fee.

I. Summary of Examiner's Rejections

Prior to the Office Action mailed May 30, 2008, Claims 1-54 were pending in the Application. In the Office Action, Claims 12-33 and 47-54 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 11, 23-33, 43-46 and 51-54 were rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Claims 1-54 were rejected under 35 U.S.C. § 102(b) based upon alleged public use or sale of the invention.

II. Summary of Applicants' Amendments

The present Reply amends Claims 1, 7, 9-10, 12-23, and 47-50; cancels Claims 5-6; leaving for Examiner's present consideration Claims 1-4 and 7-54. Reconsideration of the Application is respectfully requested.

III. Claim Rejections under 35 U.S.C. §112

In the Office Action mailed May 30, 2008, Claims 12-33 and 47-54 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, Claims 12-23 and 47-50 have been amended as shown above. Applicant respectfully submits that Claims 12-33 and 47-54 as amended now conform to the requirements of 35 U.S.C. §112, and reconsideration thereof is respectfully requested.

IV. Claim Rejections under 35 U.S.C. §101

In the Office Action mailed May 30, 2008, Claims 1-4, 11, 23-33, 43-46 and 51-54 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Accordingly, Claims 1 and 23 have been amended as shown above. Applicant respectfully submits that Claims 1-4, 11, 23-33, 43-46 and 51-54 as amended now conform to the requirements of 35 U.S.C. §101, and reconsideration thereof is respectfully requested.

V. Claim Rejection under 35 U.S.C. §102(b)

In the Office Action mailed May 30, 2008, Claims 1-4 and 7-54 were rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. In particular, Claims 1-4 and 7-54 were rejected in light of a December 6, 1999 article titled "BEA Announces Product Strategy to Bridge the Gap Between E-Generation Expectations and E-Business Performance" that describes: "As part of the rollout, each division today announced roadmaps for its products, with the E-Commerce Server Division debuting its newest product, BEA WebLogic Enterprise 5.0, at today's symposium." Based on this article and its associated press release, it was alleged that there was a public use or sale of the invention on December 6, 1999.

Applicant respectfully submits that it is unclear whether the December 6 article provides a basis for rejecting Claims 1-4 and 7-54 under 35 U.S.C. §102(b). While the article appears to indicate that WebLogic Enterprise 5.0 would be debuted, it provides no details as to what the debut would entail. As noted in the MPEP, "public knowledge is not necessarily public use under 35 U.S.C. 102(b). Mere knowledge of the invention by the public does not warrant rejection under 35 U.S.C. 102(b). 35 U.S.C. 102(b) bars public use or sale, not public knowledge." MPEP 2133.03(a)(II). As such, Applicant respectfully submits that it is unclear whether the debut described in the article constitutes public use, or whether it is more properly considered public knowledge. It is also unclear whether the version of the product being debuted included the claimed invention, or whether the invention was added to the product at a later time, prior to its official release.

It was also asserted in the Office Action that the article, and its associated press release, constitutes commercial exploitation of the claimed invention. However, as noted above, mere knowledge of the invention by the public does not warrant rejection under 35 U.S.C. 102(b). As such, Applicant respectfully submits that it is unclear whether the cited article, and its associated press release, establishes that there was a public use or sale of the claimed invention on December 6, 1999. Applicant respectfully invites the Examiner to contact the undersigned to determine which additional information the Examiner may feel necessary to fully consider this matter, or if the Applicant can be of any further assistance in this regard.

VI. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136 for extending the time to respond up to and including December 1, 2008.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: December 1, 2008

By: /Nathan Feld /
Nathan Feld
Reg. No. 59,725

Customer No. 23910
FLIESLER MEYER LLP
650 California Street, 14th Floor
San Francisco, California 94108
Telephone: (415) 362-3800